

REMARKS

Claims 1, 3, 6-7, 9-18, and 21-40 are pending. Claims 1, 3, 6, 7, 9-18, 21-30, and 34-40 are allowed. Claims 17 and 31 are amended. No new matter is entered.

Claim Rejections: 35 U.S.C. § 101

Claims 31-33 were rejected under 35 U.S.C. § 101 for not reciting subject matter eligible for patenting. The Examiner stated (quoting 1300 OG 142 “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,” 22 November 2005) (emphasis in office action):

[M]erely determining (claim 31, line 12) would not appear to be sufficient to constitute a tangible result, since the outcome of the determining step has not been used in a disclosed practical application nor made available in such a manner that its usefulness in a disclosed practical application can be realized. . . . ‘In determining whether the claim is for a “practical application,” the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather that the final result achieved by the claimed invention is “useful, tangible, and concrete.”’ Since the last step in claim 31 is not tangible, the entire claim is deemed to not comply with subject matter eligibility requirements.

Claim 31 is eligible for patent protection because it produces a “useful, concrete and tangible result.”¹ The result of claim 31 is “a value indicative of a rate at which [a] liquid advances along [a] test strip.” As amended, the value is determined with a processor. One may use the value to confirm proper operation of the test strip. Accordingly, claim 31 is useful because the value has a specific, substantial and credible utility.² The utility can be realized because the value is available, e.g., internally to the processor or upon output by the processor. The utility of claim 31 is concrete in that it can be repeated (e.g., for different test strips).³ Accordingly, the value is tangible in that it is a useful real world result.⁴ For at least these reasons, claim 31 as amended defines

¹ 1300 OG 142 (22 November 2005) (citing *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998)).

² Id.

³ Id.

⁴ Id.

patentable subject matter. Claims 32-33 depend from claim 31 and so also define patentable subject matter. Applicants accordingly request reconsideration and withdrawal of the rejection.

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